

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Applicant: BLANCO-PILLADO Maria-Jesus

Group Art Unit: 1625

Serial No.: 10/552131

Filed: April 14, 2009

Examiner: Chang, Celia C

Patent No.: 7608629

Issued: October 27, 2009

PCT Nat'l Entry

Date (if applicable): October 11, 2005

For: (PIPERIDINYLOXY)PHENYL,
(PIPERIDINYLOXY)PYRIDINYL,
(PIPERIDINYLSULFANYL)PHENYL
AND
(PIPERIDINYLSULFANYL)PYRIDINYL COMPOUNDS AS
5-HT1F AGONISTS

Docket No.: X14441

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
INDICATED AT ISSUANCE
(37 C.F.R. § 1.705)

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit herewith this Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. § 1.705 in the above-referenced issued application, accompanied by the requisite fee under 37 C.F.R. § 1.18(e). . Applicants believe that no additional fees are due with the filing of this Request. However, if any fees are required, Applicants hereby authorize the Commissioner to charge such fee, or credit any overpayment in fees, to Deposit Account No. 05-0840. One original and one copy of this request are enclosed.

Applicants received the Notice of Issuance from the U.S. Patent and Trademark Office, mailed on **Oct. 7, 2009**, with notification that the Patent Term Adjustment under 35 U.S.C. §154(b) is **290** days. By this paper, Applicants hereby petition the U.S. Patent and Trademark Office for reconsideration of the patent term adjustment calculation to **454** days based on the facts provided herein. This request is submitted in view of the decision by the U.S. District Court in *Wyeth v. Dudas* (D.D.C. 2008) on September 30, 2008.

The Statement of facts involved:

According to the provisions of 37 C.F.R. § 1.702(b), Applicants are entitled to Patent Term Adjustment for the failure of the Office to mail a notice under 35 U.S.C. 132 within 14 months of the fulfillment of the requirement of 35 U.S.C. 371, and to issue the patent within three years after the date on which the application was filed. The amount of Adjustment depends on the date that the instant application issued as a patent, **Oct 27, 2009**, and should be counted from **Oct 18, 2005**, when 35 U.S.C. 371 was satisfied, subtracting time legitimately attributable to applicant delay and delay overlap under 37 C.F.R. §1.703(f) as interpreted in *Wyeth v. Dudas*, *supra*. Notification sent concurrently with the Notice of Allowance mailed on Oct 7, 2009 stated a PTA of 290 days, which time only accounts for the period under 37 C.F.R. §1.702(b)&(e) and neglects the period under 37 C.F.R. §1.702(a). Applicants submit that the number of days under 37 C.F.R. § 1.702(b) should sum to a total of 454 days of PTA and is calculated as follows:

Day after the date that is three years after the filing

per 35 USC 371 or 35 USC 111: Oct 19, 2008

Date of issuance: Oct 27, 2009

Date of filing of any request for continued

examination: N/A

Adjustment under 1.705 (a)-(c) as determined or raised prior to issuance :

290 days.

Present request for adjustment under 1.703 (a)-(f), as applicable:

164 additional days.

Total patent term adjustment, including previously determined patent term

adjustment plus the adjustment herein requested: 454 days.

37 C.F.R. §1.702(a) through (e) is the sum of the following periods as calculated under 37 C.F.R. §1.703(a) through (e):

37 C.F.R. §1.703(a)(1)	192	days	(Over 14 months to first notice) (Dec. 19, 2006 to Jun. 28, 2007)
37 C.F.R. §1.703(a)(2)	4	days	(Over 4 months after reply) (Aug. 22, 2009 – Aug 25, 2009)
37 C.F.R. §1.703(b)	151	days	(Over 3 years to issue patent) (381 days less 230 days under 37 C.F.R. §1.703(b)(4) appellate review) (Oct 18, 2005 – Oct 27, 2009, less June 6, 2008 – Jan 22, 2009)
37 C.F.R. §1.703(c)	0	days	
37 C.F.R. §1.703(d)	0	days	
37 C.F.R. §1.703(e)	230	days	(Appellate Review) (June 6, 2008 – Jan 22, 2009)
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Total 1.703 § (a)-(e):	577	days	

This period is reduced under 37 C.F.R. §1.703 & §1.704 as follows:

37 C.F.R. §1.704(b)	84	days	(Extensions) (Sept. 29, 2007 – Nov. 28, 2007 & May 15, 2008 – June 6, 2008)
37 C.F.R. §1.704(c)(7)	35	days	(Noncompliant appeal brief) (Oct. 8, 2008 – Nov. 5, 2008)
37 C.F.R. §1.703(f)	4	days	(Overlap of 3 yr. guarantee with delay of response after reply under 37 C.F.R. §1.703(a)(2) (Aug. 22, 2009 – Aug 25, 2009)
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Total 1.704 § (a)-(e):	123	days	

The correct PTA is then **577 days – 123 days = 454 days.**

This request for patent term adjustment raises new issues raised with the Issue Notification of Oct 7, 2009 and is filed within 30 days of the date the patent issued.

The patent is not subject to a terminal disclaimer.

Circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704 have been appropriately accounted for as set forth above.

Applicants request correction of the patent term adjustment, in accordance with 35 USC 154(b)(1)(B), to add the adjustments attributable to 37 C.F.R. §1.702 (a)-(e), set forth herein above.

Thus, Applicants respectfully submit that the correct total patent term adjustment considering the previous adjustments before issuance of 290 days plus the corrected adjustment noted after issuance of 164 days, should properly result in a total patent term adjustment of 454 days.

Respectfully submitted,

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